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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,665	09/10/2003	Lawrence Shuniak	4024.002	3725
41288	7590	12/06/2005	EXAMINER	
PENDORF & CUTLIFF 5111 MEMORIAL HIGHWAY TAMPA, FL 33634-7356			NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,665

Applicant(s)

SHUNIAK, LAWRENCE

Examiner

Ismael Negron

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 is/are rejected.
7) ☒ Claim(s) 1,3,7-10,13 and 14 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on October 3, 2005 has been entered. Claims 1, 8 and 12 have been amended. No claim has been cancelled. Claims 13 and 14 have been added. Claims 1-14 are still pending in this application, with claims 1, 13 and 14 being independent.

Claim Objections

2. Claim 1 is objected to because of the following informalities: it recites the limitation "*the segmented body*" in line 9. There is insufficient antecedent basis for this limitation in the claim.

The cited lack of antecedent instances do not amount to indefiniteness under 35 U.S.C. 112, second paragraph, since it is readily apparent that the claims are referring back to the previously recited "*segment bodies*" (line 3). However, appropriate correction is required to place the claims in proper form for allowance. The Examiner suggests amending line 9 to read: "adjacent ~~segmented~~ **segment** body".

3. In addition, note claims 3, 7-10, 13 and 14 for the same reasons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 5, 7-9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by THIEL (U.S. Pat. 1,875,956).

5. THIEL discloses an illumination device having:

- **at least two segment bodies (as recited in claims 1, 13 and 14),**
Figure 1, reference characters B and D;
- **the at least two segmented bodies being detachable (as**
recited in claims 1 and 13), as evidenced by page 1, lines 85-98;
- **the segment body having a housing (as recited in claims 1 and**
13), Figure 1, reference characters B and D;
- **the segment body having at least one light source (as recited**
in claims 1 and 13), Figure 3, reference numbers 16 and 32;
- **the light source being located inside the housing (as recited in**
claims 1 and 13), as seen in Figure 3;
- **the segmented body having a power source (as recited in**
claims 1 and 13), Figure 3, reference number 11;
- **the power source being for powering the light source (as**
recited in claims 1 and 13), page 1, lines 71-74;
- **the segment body includes at least one attachment point (as**
recited in claims 1 and 13), Figure 1, reference number 17;

- **the attachment point of one body interconnecting with the attachment point of an adjacent body (as recited in claims 1 and 13), page 1, lines 85-88;**
- **the segmented body having at least one power switch (as recited in Claim 2), Figure 3, reference number 14;**
- **the switch turning the light source ON and OFF (as recited in Claim 2), page 1, lines 77-84;**
- **the power source being chosen from batteries, wood, oil, gas, propane, AC electric power, or combination thereof (as recited in Claim 4), page 1, line 72;**
- **the light source is chosen from LED, incandescent bulb, florescent bulb, or combinations thereof (as recited in Claim 5), page 1, line 80;**
- **the segmented body including a transparent or translucent globe (as recited in Claim 7), Figure 3, reference number 13;**
- **the globe housing the light source (as recited in Claim 7), as seen in Figure 3;**
- **each segment body being placed next to one another forming a closed unit (as recited in Claim 13), as seen in Figure 1;**
- **each segment body being shaped to complement the shape of the adjacent segment body to form a closed unit (as recited in Claim 13), as seen in Figure 1.**

6. Method claims 8, 9, 11 and 12 were considered as inherently disclosed by the structural limitations of the patented device of THIEL (as detailed above).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 6 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over THIEL (U.S. Pat. 1,875,956).

8. THIEL discloses an illumination device having:

- **at least two segment bodies (as recited in Claim 1), Figure 1, reference characters B and D;**
- **the at least two segmented bodies being detachable (as recited in Claim 1), as evidenced by page 1, lines 85-98;**
- **the segment body having a housing (as recited in Claim 1), Figure 1, reference characters B and D;**
- **the segment body having at least one light source (as recited in Claim 1), Figure 3, reference numbers 16 and 32;**

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- **the light source being located inside the housing (as recited in Claim 1), as seen in Figure 3;**
- **the segmented body having a power source (as recited in Claim 1), Figure 3, reference number 11;**
- **the power source being for powering the light source (as recited in Claim 1), page 1, lines 71-74;**
- **the segment body includes at least one attachment point (as recited in Claim 1), Figure 1, reference number 17; and**
- **the attachment point of one body interconnecting with the attachment point of an adjacent body (as recited in Claim 1), page 1, lines 85-88.**

9. THIEL discloses all the limitations of the claims, except:

- The at least one segmented body including at least one hook (as recited in Claim 3);
- the hook being for hanging each segmented body (as recited in Claim 3);
- main power switch means (as recited in Claim 6); and
- the illumination device being turned ON or OFF by the main power switch means (as recited in Claim 6).

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include at least one hook in at least one of the segmented

bodies of THIEL (as recited in Claim 3), since the Examiner takes Official Notice that the use of such hooks is old and well known in the art. One would have being motivated to be able to secure the body to a supporting structure by hanging it from the hook.

11. Regarding the illumination device having a main power switch means (as recited in Claim 6), it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a master switch in the illumination device of THIEL, to be able to turn OFF all the light sources of the device of THIEL actuating only one switch as opposed to the multiple single switches of THIEL.

12. Method Claim 10 was considered as inherently disclosed by the structural limitations of the patented device of THIEL (as detailed above).

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over THIEL (U.S. Pat. 1,875,956).

14. THIEL discloses an illumination device having:

- **at least two segment bodies (as recited in Claim 14),** Figure 1, reference characters B and D;
- **the at least two segmented bodies being detachable (as recited in Claim 14),** as evidenced by page 1, lines 85-98;
- **the segment body having a housing (as recited in Claim 14),** Figure 1, reference characters B and D;

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- **the segment body having at least one light source (as recited in Claim 14), Figure 3, reference numbers 16 and 32;**
- **the light source being located inside the housing (as recited in Claim 14), as seen in Figure 3;**
- **the segmented body having a power source (as recited in Claim 14), Figure 3, reference number 11;**
- **the power source being for powering the light source (as recited in Claim 14), page 1, lines 71-74;**
- **the segment body includes at least one attachment point (as recited in Claim 14), Figure 1, reference number 17;**
- **the attachment point of one body interconnecting with the attachment point of an adjacent body (as recited in Claim 14), page 1, lines 85-88;**
- **each segment body being placed next to one another forming a closed unit (as recited in Claim 14), as seen in Figure 1;**
- **each segment body being shaped to complement the shape of the adjacent segment body to form a closed unit (as recited in Claim 14), as seen in Figure 1.**

15. THIEL discloses all the limitations of the claims, except segment body having a triangular shape (as recited in Claim 14).

16. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a triangular segment body, since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). It appears that the disclosed device would perform equally well shaped as disclosed by THIEL.

In addition, it is noted that not only is the specification silent as to any advantage of shaping the claimed segment bodies specifically as a triangle, but it also fails to state that any shape is preferred over one another, strongly suggesting that the shape of the segment bodies is not a defining feature of the claimed invention.

Relevant Prior Art

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. **Engelhardt et al.** (U.S. Pat. 2,602,880), **Cruz** (U.S. Pat. 2,778,931), **Kovacik et al.** (U.S. Pat. 4,626,327) and **McBride** (U.S. Pat. 4,428,033) disclose illumination device having hooks for supporting such illumination devices.

Response to Arguments

19. Applicant's arguments filed October 3, 2005 have been fully considered but they are not persuasive.

20. Regarding the Examiner's rejection of Claim 1 under 35 U.S.C. 102(b) as being anticipated by THIEL (U.S. Pat. 1,875,956), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically detachable segment bodies, or at least one attachment point to interconnect each segmented body to an adjacent segmented body. The applicant further argues that the flashlights of the patented structure of THIEL are not *easily* detachable, and that it was designed for an entirely different application than that of the claimed invention.

21. In response to applicant's surprising arguments that THIEL failed to disclose detachable segment bodies, the applicant is respectfully advised that while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 70 USPQ2d 1827 (Fed. Cir. May 13, 2004).

In this case, THIEL discloses an illumination device formed by a plurality of casings A, B and C. The casings are interconnected to one another by clamping members 18, such clamping members being operated by a bolt 22. Applicant's argument about the casings of THIEL are not been detachable segments fly in the face

of fact, as they are clearly individual segments of the whole illumination device, and, since bolt 22 is a removable fastener, they are clearly capable of being detached from one another, ergo detachable. See THIEL Figure 2.

22. In response to applicant's surprising arguments that THIEL failed to disclose the detachable segment bodies including at least one attachment point to interconnect each segmented body to an adjacent segmented body, the applicant is respectfully directed to Figure 2 of THIEL.

THIEL shows a clamping member 18 for attaching each body to an adjacent body, such clamping member inherently defining an attachment point at its contact point with the segmented bodies it supports.

23. Regarding applicant's arguments that the flashlights of the patented structure of THIEL are not *easily* detachable, or that the patented structure was designed for an entirely different application than that of the claimed invention, it is noted that the features upon which applicant relies (i.e., *easily* detachable) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The applicant is strongly advised that, while it might be clear from the instant specification and drawings that the patented structure of THIEL is fundamentally different from the instant invention, such evaluations are irrelevant, as the claimed invention is defined by the claims.

24. Regarding the Examiner's rejection of Claim 3 under 35 U.S.C. 103(a) as being unpatentable over THIEL (U.S. Pat. 1,875,956), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically a hook for hanging the segmented body. The applicant further argues that the Examiner's conclusion of obviousness was based on improper hindsight reasoning. The Applicant even further argues that the Examiner failed to specifically point out where in THIEL was a hook suggested, and that there is no motivation to modify the patented device to include the claimed hook.

25. In response to applicant's arguments that THIEL fails to disclose a hook for hanging the segmented body, the applicant is respectfully directed to Section 8 of the instant Office Action, where such limitation is discussed along with rationale for motivation.

It seems that the applicant is of the opinion that the missing elements must be found in, or specifically suggested by the THIEL reference, however, such opinion is not correct. The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992). See MPEP § 2144.

In this case, the use of hooks for providing attachment means to illumination devices is old and well known in the art. Evidenced of such "old and well known in the art" status of Hooks can be found in previous Section 11.

In addition, it is noted that the claimed language defines the hook as being included in at least one segmented body, not that a hook is included in each segmented body.

26. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, as previously stated in Section 18, the use of hooks for providing attachment means to illumination devices is old and well known in the art. Including a hook in the illumination device of THIEL would have flown naturally to one of ordinary skill in the art to provide means for supporting such illumination device.

27. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Once again, the applicant is advised that the use of hooks for providing attachment means to illumination devices is old and well known in the art. Including a hook in the illumination device of THIEL would have flown naturally to one of ordinary skill in the art to provide means for supporting such illumination device.

28. Regarding the Examiner's rejection of Claim 6 under 35 U.S.C. 103(a) as being unpatentable over THIEL (U.S. Pat. 1,875,956), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically a main power switch. The Applicant further argues that the Examiner failed to specifically point out where in THIEL was a main switch suggested, and that there is no motivation to modify the patented device to include the claimed main switch, as they (the applicant) *"do not want to turn all the flashlights at once, but rather one by one, until de desired intensity is obtained"*.

29. In response to applicant's arguments that the Examiner failed to specifically point out where in THIEL was a main switch suggested, and that there is no motivation to modify the patented device to include the claimed main switch, the applicant is respectfully directed to Section 18, where such arguments are discussed as they apply to Claim 3.

30. In response to applicant's arguments that there is no motivation to modify the patented device of THIEL to include the claimed main switch, the applicant is respectfully directed to Section 9 of the instant Office Action, where such limitation is discussed along with rationale for motivation.

Regarding applicant arguments that they (the applicant) "*do not want to turn all the flashlights at once, but rather one by one, until de desired intensity is obtained*", it is noted that the applicant argues that turning all the light sources of THIEL ON at the same time would present no advantage to the patented structure as the intention was to energize them on by one, however, ignores the fact that such main power switch is also used to turn the light sources OFF. While turning all the light sources ON might, in arguendo, fail to provide an advantage, it is a fact that being capable of turning all the light sources OFF by actuating a main power switch (instead than actuating a plurality of switches) would have indeed been advantageous.

31. In response to applicant's arguments regarding newly presented claims 13 and 14, the applicant is respectfully directed to sections 3 and 11-14 of the instant Office Action where a rejection of the structural limitations presented by such claims is detailed.

Conclusion

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

33. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (571) 273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



THOMAS M. SEMBER
PRIMARY EXAMINER



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AU 2875